

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: Damir et al.

Attorney Docket No. SWAD-1-1002

Serial No.: 10/751,070

Group Art Unit: 3765

Filing Date: January 2, 2004

Examiner: Gloria M. Hale

Title: SWADDLING BLANKET

**APPEAL BRIEF**

TO THE COMMISSIONER FOR PATENTS:

This brief is in furtherance of the Notice of Appeal, filed in this case on June 30, 2008.  
The fees required under CFR § 41.20(b)(2) are submitted herewith.

25315

CUSTOMER NUMBER

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I. REAL PARTY IN INTEREST

SwaddleDesigns, LLC is the assignee of the present application and is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

None.

III. STATUS OF CLAIMS

Claims 39, 41, and 44-51 are pending. Claims 39, 41, and 44-51 were rejected in the Final Office Action mailed April 30, 2008. The final rejection of Claims 39, 41, and 44-51 is appealed.

IV. STATUS OF AMENDMENTS

An amendment was filed on December 12, 2007 in response to the Non-Final Office Action mailed July 12, 2007, which rejected all claims under 35 U.S.C. § 112, though patentable matter was recognized in the currently pending Claims 39, 41, and 44-51. The subsequent Final Office Action, mailed April 30, 2008, rejected the same claims as obvious. No further amendments to the claims have been made or requested. Thus, as the amendments now stand, they read as follows:

1. – 38. (Cancelled).

39. (Previously Presented). A blanket for swaddling an infant, the blanket comprising:

a generally planar sheet of textile material having a first-fold illustration, second-fold illustration, and third-fold illustration attached to the blanket and being integrated into a sequence;

the first-fold illustration locating and instructing the folding of a first fold line and folding of the blanket to cover the infant;

the second-fold illustration locating and instructing the folding of a second fold line and folding of the blanket to cover the infant; and



the third-fold illustration locating and instructing the folding of a third fold line and folding of the blanket to cover the infant.

40. (Cancelled).

41. (Previously Presented). The blanket of Claim 39, wherein the blanket further comprises a no-fold illustration locating and instructing the placement of an infant on the blanket.

42. (Cancelled).

43. (Cancelled).

44. (Previously Presented). The blanket of Claim 41, where the first-fold, second-fold, and third-fold illustrations are attached to the blanket in positions orienting the blanket with respect to the infant.

45. (Previously Presented). The blanket of Claim 39, wherein the first-fold, second-fold, and third-fold illustrations are printed on the blanket.

46. (Previously Presented). The blanket of Claim 39, wherein the first-fold, second-fold, and third-fold illustrations are embroidered on the blanket.

47. (Previously Presented). The blanket of Claim 39, wherein the first-fold, second-fold, and third-fold illustrations are embossed on the blanket.

48. (Previously Presented). The blanket of Claim 39, wherein the first-fold, second-fold, and third-fold illustrations are labeled on the blanket.

49. (Previously Presented). The blanket of Claim 39, wherein the first-fold, second-fold, and third-fold illustrations are appliquéd on the blanket.

50. (Previously Presented). The blanket of Claim 39, wherein the first-fold, second-fold, and third-fold illustrations are woven into the blanket.

51. (Original). The blanket of Claim 39, wherein the first-fold, second-fold, third-fold illustrations are detachably attached to the blanket.

All of the pending claims, Claims 39, 41, 44 through 51 have been rejected and all of the pending claims are the subject of this appeal.



## V. SUMMARY OF CLAIMED SUBJECT MATTER

The invention relates to generally to a blanket with attached illustrations instructing the user as to the proper manner for swaddling an infant.

Independent Claim 39 recites a blanket for swaddling an infant, the blanket comprising: a generally planar sheet of textile material having a first-fold illustration, second-fold illustration, and third-fold illustration attached to the blanket and being integrated into a sequence: the first-fold illustration locating and instructing the folding of a first fold line and folding of the blanket to cover the infant; the second-fold illustration locating and instructing the folding of a second fold line and folding of the blanket to cover the infant; and the third-fold illustration locating and instructing the folding of a third fold line and folding of the blanket to cover the infant.

The support in the Specification for each section of the Independent Claim is found in, at least, the following locations:

A blanket for swaddling an infant, the blanket comprising:	
a generally planar sheet of textile material having a first-fold illustration, second-fold illustration, and third-fold illustration	Page 4, Lines 19-27; Page 4, Line 28 to Page 5, Line 21
attached to the blanket and being integrated into a sequence	Page 3 Lines 23 to 32: Figs. 1a, 1b, 2, and 3
the first-fold illustration locating and instructing the folding of a first fold line and folding of the blanket to cover the infant;	Page 3, Line 32 to Page 4, Line 3: Figs. 1a, 1b, 2, and 3
the second-fold illustration locating and instructing the folding of a second fold line and folding of the blanket to cover the infant; and	Page 4, Line 4 to Line 10: Figs. 1a, 1b, 2, and 3
the third-fold illustration locating and instructing the folding of a third fold line and folding of the blanket to cover the infant.	Page 4, Line 11 to Line 18: Figs. 1a, 1b, 2, and 3

## VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 39, 41 and 44-51 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Isola et al.* (U.S. Patent No. 3,613,133) and common knowledge.

## VII. ARGUMENT

### **Summary that the Rejections Based Upon *Isola et al.* in View of Common Knowledge are Improper**

The rejection of the claims based upon *Isola* as a reference in view of Common Knowledge is improper for the reason that the rejection fails to recognize the claimed element of attachment of instructive folding illustrations to the blanket, as set forth in the words of independent Claim 39.

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001).

The factual inquiry is one of whether to combine references must be thorough and searching and it must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. *See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) (“a showing of a suggestion, teaching, or motivation to combine the prior art references is an ‘essential component of an obviousness holding’” (quoting *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998))); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (“there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant”); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (“teachings of references can be combined only if there is some suggestion or incentive to do so.”) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades the applicable authority. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.”); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (“the examiner can satisfy the burden of showing obviousness of the combination ‘only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references’”).

Knowledge in the prior art of every element of a patent claim, however, is not of itself sufficient to render claim obvious. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 15 L. Ed. 2d 545, 86 S. Ct. 684 (1966); *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1333, 63 USPQ2d 1374, 1386 (Fed. Cir. 2002). The Supreme Court, in *KSR, supra*, agreed that the Federal Circuit's predecessor, the Court of Customs and Patent Appeals, had “captured a helpful insight” in 1961 when it “first established the requirement of demonstrating a teaching, suggestion, or motivation to combine known elements in order to show that the combination is obvious”:

“Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.”



In the instant case, the Examiner has suggested the act of placing written content on the blanket is known, and thus, the content that is placed there is of little or no patentable significance:

*Isola et al.* discloses a blanket 16 with illustrations thereon. *Isola et al.* discloses that any known illustration desired can be placed on the blanket including scenes, articles and persons etc. (See *Isola et al.*, col.11, lines 8-48 and figure 16; and col. 5, line 41- col. 6, line 16). However, *Isola et al.* does not specifically disclose the fold illustrations on the blanket as especially claimed. Accordingly it would have been obvious to one having ordinary skill in the art to place any desired indicia on the blanket as desired for aesthetic purpose or for directions such as that disclosed in *Isola et al.* *Isola et al.* also discloses the placement of a person on a blanket. The illustration is painted on the blanket and is reproduced in any known manner such as those claimed that are well known indicia processes. (See col. 11, lines 35-49). The illustrated method of swaddling a baby in place of *Isola et al.* placement of a person on a blanket is just a change in a printed matter and would be an obvious substitution of common knowledge information that would only be limited by the imagination of the user. The only difference of the claimed invention over *Isola et al.*'s invention is the printed matter and that is not a patentable claim distinction. Since the only difference is the content of the information set forth by the indicia, then this difference is not set forth as a patentable distinction. It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. Therefore when the prior art describes all of the claimed structural and functional relationships (in this case the function of the printed matter on the blanket shows the placement of the user and wherein the blanket surfaces support the indicia, which is the same function as *Isola et al.* (between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and will not be given patentable weight. (See *in re Ngai*, 367 F 3d.1336,70 USPQ2d 1862 (Fed. Cir. 2004)).

Final Office Action, pp 2-3.

For the rejection, the Examiner relies upon *Ngai*, for the proposition that adding written matter to an existing device is not a patentable innovation. Known as the “Written Matter” doctrine, it has drawn frequent criticism from the courts as lacking in more germane analysis as to actual patentability. In *Ngai*, instructions for a novel use of a known kit of ingredients did not make the subject matter a distinctly patentable invention.



The Examiner's reliance upon *Ngai* is misplaced as the instant claims are directed to a device where the printed matter has a functional relationship to the substrate as in an earlier case, *In re Gulack*:

Ngai argues that the addition of new printed matter to a known product makes the product patentable. He rests his argument on the fact that claim 19 is limited to kits containing instructions teaching the method described in claim 1. Ngai argues that because prior art does not teach a limitation of "instructions describing the method of claim 1," combined with an amplification kit, the petitioner's claim cannot be anticipated. Ngai relies on the language of *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983): "[The] difference between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter." *Id.* at 1385.

The PTO argues that Ngai's claim merely teaches a new use for an existing product. Thus, according to the PTO, Ngai can claim the new use as a method, but he cannot claim the existing product itself. The PTO relies on a different passage of *Gulack* and argues that in order to qualify under *Gulack*, the printed matter must be functionally related to the underlying object. "The critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate." *Id.* at 1386.

The dispute between Ngai and PTO reduces to the question of the proper meaning of *Gulack*. The PTO has the better argument. In *Gulack*, the Board rejected a claim directed to a circular band designed for mathematical and educational purposes. The invention consisted of "(1) a band, ring, or set of concentric rings; (2) a plurality of individual digits imprinted on the band or ring at regularly spaced intervals; and (3) an algorithm by which the appropriate digits are developed." *Id.* at 1387. The rejection was premised upon the fact that a circular band with items printed upon it was well known in the art. *See id.* at 1384. We reversed, finding that the numbers printed on the band had a functional relationship to the band itself. The Court stated: "the[] digits are related to the band in two ways: (1) the band supports the digits; and (2) there is an endless sequence of digits--each digit residing in a unique position with respect to every other digit in an endless loop. Thus, the digits exploit the endless nature of the band." *Id.* at 1386-87. Although the prior art disclosed a band with printed matter, the Court concluded that the prior art neither "disclosed nor suggested either feature" of *Gulack's* invention. *Id.* at 1387.

*In re Ngai*, 367 F.3d 1336, 1338-1339 (Fed. Cir. 2004).





In fact, if the Examiner herself believed that *Ngai* dictated a conclusion that the exact content of the printed matter is irrelevant, the Examiner would have rejected the claims on anticipation rather than obviousness reasons. It is Appellants' position that the rejection of the claims on a "printed matter" basis is simply incorrect in this case, and the nature of the rejection admits that. Unlike *Ngai*, the instructions are attached and that attachment is a distinct element. Appellants have repeatedly argued throughout the prosecution of the current claim set that the invention is not simply a blanket and a set of instructions, but rather that the blanket and the set of instructions are functionally linked as were the characters of *Gulack*: "the[] digits are related to the band in two ways: (1) the band supports the digits; and (2) there is an endless sequence of digits--each digit residing in a unique position with respect to every other digit in an endless loop. Thus, the digits exploit the endless nature of the band." *Gulack* at 1386-87.

In the instant case, the instructions have a real and tangible link to the blanket: (1) the blanket supports the illustrations; and (2) the illustrations aid in the appropriate use of the blanket during times when the infant is crying and ready reference to the instructions might be necessary given a user's emotional state. Independent Claim 39 and the remaining claim include limitation that instructive illustrations be attached to the blanket. The attachment between blanket and instructions has been intimately related to the utility of the invention as taught in the specification, unlike *Ngai* wherein it was the mere inclusion of instructions in a kit that had a separate cited utility. It is the claimed "attachment" that has been largely ignored as a limitation by the Examiner throughout the prosecution process. Instead, as is demonstrated by the current rejection of claims in view of *Isola et al.*, the Examiner is unwilling to view this bond between instruction and blanket as a distinct element of the claim.

The state of the law is *Gulack*. *Ngai* does not purport to change the law as it is set forth in *Gulack*, but it does assert that it applies *Gulack* to the facts of the case before it. Therefore, the admonitions in *Gulack* must retain all of their full vigor. *Gulack* cautioned against a liberal use of "printed matter rejections" under section 103:

A "printed matter rejection" under § 103 stands on questionable legal and logical footing. Standing alone, the description of an element of the invention as printed matter tells nothing about the differences between the invention and the prior art or about whether that invention was suggested by the prior art. . . . [The Court of



Customs and Patent Appeals], notably weary of reiterating this point, clearly stated that printed matter may well constitute structural limitations upon which patentability can be predicated. *Gulack*, 703 F.2d at 1385 n.8.

*In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994).

As the *Gulack* court properly noted, 35 U.S.C. § 103(a) requires that the invention be viewed *as a whole*:

§103. Conditions for patentability; non-obvious subject matter.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are ***such that the subject matter as a whole would have been obvious at the time the invention was made*** to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

It is ironic that citation to *Isola et al.* itself admits that there exists a separate element that is the link between the blanket and what is printed on it. *Isola et al.* is directed to “A set of bed clothes including at least two individual bed clothes elements, one at least partly overlying the other; the elements having means provided thereon defining a composite pictorial illustration of a person, character, animal, article, or scenic background, with the composite illustration consisting of the person, character, etc. appearing in one condition on one of the bed clothes elements and appearing in a different condition on the other of the elements, so that when the bed is viewed with one of the elements overlying the other thereof, the depicted person, character, etc. appears to be in one condition, and when the uppermost of the elements is at least in part removed or folded back from its overlying relation to the other of the elements, the person, character, etc. is viewed as being in the second condition.” Abstract, U.S. Patent No. 3,613,133. Certainly no one asserts that the bed clothes were a novel element. Likewise, neither the illustrations of Raggedy Ann™, Raggedy Andy™, nor the image of the Spaceman shown in the illustrations, FIGS 1-4b, impart separate patentability. *Isola et al.* was granted based upon the additional element of the presence of the characters on the bed clothes. Now the Office seeks to



rely upon this patent to disavow the presence of distinct content, but whose nature the *Isola et al.* grant specifically recognizes.

In this case, it is the attachment of the graphic instructions to the blanket that is the patentable limitation present in each of the pending claims. The attachment element lends the patentability to the currently pending claims.

Additionally, the Examiner has vacillated as to the allowability of the claims, alternately recognizing and denying the utility of attachment of the instructions to the blanket. In a prior Office Action dated February 7, 2007, the Examiner stated that Claims 39, 41, and 44-50 would be allowable “if rewritten or amended to overcome the rejection under 35 USC §112.” After Appellants did so amend, the Examiner withdrew the offer of allowability. After amending the claims in accord with the stated allowability of the claims, the Examiner, in the July 12, 2007 Office Action, first brought up the citations to *Isola et al.* and *Ngai* to disavow the allowability of Claims 39, 41, and 44-50.

In response to the *Isola et al.* reference, Appellants submitted the Declarations of Lynette Damir and Pamela Jordan. Attachment 1 is the Declaration of Lynette Damir, R.N., the inventor of the invention taught in the instant application; Attachment 2 is the declaration of Pamela Jordan, Ph.D., R.N. Each of the Declarations addresses the absence of a similar product in the marketplace. Both go on to assert additional indicia of uniqueness of the instant invention in the manner set forth as “secondary considerations” in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), where the United States Supreme Court clarified the nonobviousness requirement in United States patent law, set forth in 35 U.S.C. § 103. This Response incorporates the two attachments by this reference.

The Patent Act of 1952 added 35 U.S.C. § 103, which added the statutory requirement of nonobviousness. The section essentially requires a comparison of the subject matter sought to be patented and the prior art, in order to determine whether or not the subject matter of the patent as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Congress, in passing the Act, intended to codify and clarify the common law surrounding the Patent Act by making explicit the requirement of nonobviousness. In

*Graham*, the Supreme Court held that, although patentability is a matter of law, § 103 required a determination of the following questions of fact to resolve the issue of obviousness:

- the scope and content of the prior art;
- the level of ordinary skill in the prior art;
- the differences between the claimed invention and the prior art; and

In addition, the Court mentioned “secondary considerations” which could serve as indicia of nonobviousness. They include:

- commercial success;
- long-felt but unsolved needs; and
- failure of others.

The record now includes the two declarations attesting to the presence of the *Graham* factors as secondary indications of nonobviousness. For a proper rejection of a claim under 35 U.S.C. § 103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly or explicitly, all elements, features and steps of the claim at issue. *See, e.g., In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). *Glaverbel S.A. v. Northlake Mkt'g & Supp., Inc.*, 45 F.3d 1550, 33 USPQ 2d 1496 (Fed. Cir. 1995) (“the claimed process, including each step thereof, must have been described or embodied, either expressly or inherently.”) As clearly articulated in M.P.E.P. § 2143.03, “[to] establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (C.C.P.A. 1970). (Emphasis added.)

In *KSR*, cited above, the Supreme Court reaffirmed the importance of secondary considerations when reviewing an application for patentability. The policy of the United States Patent and Trademark Office is to follow *Graham v. John Deere*. M.P.E.P. § 2141. A procedure for evaluating an application in light of the *Graham* case is set forth at M.P.E.P. § 2141, which

requires that objective evidence must be considered. The Examiner has not duly recognized the significance of these Declarations in determining the nonobviousness of the claims.

As Mrs. Damir, in her Declaration, points out, the blanket has enjoyed tremendous commercial success, especially in discriminating markets as well as a long-felt need, the failure of others, and copying by others. As the Examiner certainly is aware, the Courts have held that such evidence is suitably conclusive on the issue of non-obviousness: Mrs. Damir suitably points out incidents of praise and industry acceptance (each relevant under *Allen Archery, Inc. v. Browning Mfg. Co.*, 819 F.2d 1087, 1092, 2 USPQ2d 1490, 1493 (Fed. Cir. 1987) as well as copying (*Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675,679, 7 USPQ2d 1315, 1319 (Fed. Cir. 1988)). In light of the supplied evidence, the claims are not obvious. Appellants assert that the rejection on the basis of obviousness can no longer stand in light of this evidence of secondary considerations.

The Supreme Court of the United States and the Federal Circuit Court of Appeals have also provided further guidance for resolving the question of obviousness. “An obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not. *See KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739, 167 L.Ed.2d 705 (2007).” *Leapfrog Ent., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 82 USPQ2d 1687 (Fed. Cir. 2007). (Emphasis added.)

“Although common sense directs caution as to a patent application claiming as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does. Inventions usually rely upon building blocks long since uncovered, and claimed discoveries almost necessarily will be combinations of what, in some sense, is already known.” *KSR* at 1731.

In *KSR, supra*, the Supreme Court noted that it will be necessary for a court “to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be explicit.” *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 1746, 1741 (2007). “[R]ejections on obviousness grounds

cannot be sustained by mere conclusory statements; instead, *there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*” *Id.* at 1746, quoting *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006). (Emphasis added.)

In decisions after *KSR*, *supra*, the Board of Patent Appeals and Interferences has failed to sustain obviousness type rejections when the Examiner has failed to make a proper prima facie case of obviousness. See *Ex parte Kato et al*, Appeal 2007-1460 (obviousness rejection not sustained because there was “no evidence or suggestion” in the reference for the alleged configuration); and *Ex parte Crawford et al*, Appeal 2006-2429 (obviousness rejection not sustained because there was no suggestion to combine the references in the manner suggested by the Examiner except for using Appellants’ invention as a template through hindsight reconstruction of Appellants’ claims).

In this case, the blanket with attached instructive illustrations was first found to be allowable matter. Since then, the Examiner has failed to show why citation to *Isola et al.* renders the instant claims obvious when no such blanket has earlier existed on the market and when, upon its introduction, the market immediately accepts the blanket and copiers spring up to exploit that acceptance. These indicia are at the heart of the *Graham* Court’s finding of nonobviousness, and militate for a similar finding in this case.



VIII. Conclusion

The only evidence on the record is the Declarations of Dr. Jordan and the inventor, herself a registered nurse and expert in the field. They militate toward a finding of nonobviousness as they show that the market place has immediately recognized the value of the blanket. In spite of the Examiner's suggestion that nothing in the Declarations links the success and copying to the claims under examination, the Examiner has not offered any contradictory evidence, nor any reference that itself includes instructive swaddling instructions ***attached to the blanket***. In light of this fact, and, the *Graham* factors having been suitably made part of the record, the Claims as currently entered should be allowed.

Respectfully submitted,

BLACK LOWE & GRAHAM<sup>PLLC</sup>



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IX. CLAIMS APPENDIX

39. A blanket for swaddling an infant, the blanket comprising:

a generally planar sheet of textile material having a first-fold illustration, second-fold illustration, and third-fold illustration attached to the blanket and being integrated into a sequence;

the first-fold illustration locating and instructing the folding of a first fold line and folding of the blanket to cover the infant;

the second-fold illustration locating and instructing the folding of a second fold line and folding of the blanket to cover the infant; and

the third-fold illustration locating and instructing the folding of a third fold line and folding of the blanket to cover the infant.

41. The blanket of Claim 39, wherein the blanket further comprises a no-fold illustration locating and instructing the placement of an infant on the blanket.

44. The blanket of Claim 41, where the first-fold, second-fold, and third-fold illustrations are attached to the blanket in positions orienting the blanket with respect to the infant.

45. The blanket of Claim 39, wherein the first-fold, second-fold, and third-fold illustrations are printed on the blanket.

46. The blanket of Claim 39, wherein the first-fold, second-fold, and third-fold illustrations are embroidered on the blanket.

47. The blanket of Claim 39, wherein the first-fold, second-fold, and third-fold illustrations are embossed on the blanket.



48. The blanket of Claim 39, wherein the first-fold, second-fold, and third-fold illustrations are labeled on the blanket.

49. The blanket of Claim 39, wherein the first-fold, second-fold, and third-fold illustrations are appliquéd on the blanket.

50. The blanket of Claim 39, wherein the first-fold, second-fold, and third-fold illustrations are woven into the blanket.

51. The blanket of Claim 39, wherein the first-fold, second-fold, third-fold illustrations are detachably attached to the blanket.



X. EVIDENCE APPENDIX

Attachment 1 – Declaration of Lynette Damir, R.N., the inventor of the invention taught in the instant application and a registered nurse.

Attachment 2 – Declaration of Pamela Jordan, Ph.D., R.N.

XI. RELATED PROCEEDINGS APPENDIX

Exhibit 1 – February 7, 2007 Office Action.

